

REMARKS/ARGUMENTS

In response to the Office Action mailed June 10, 2004, Applicants amend their application and request reconsideration in view of the amendments and the following remarks. In this Amendment, Claim 1 is amended, no claims are added, and Claim 8 is cancelled without prejudice so that Claims 1-7 are pending in the application. No new matter has been introduced.

The disclosure was objected to for a minor informality that has been corrected in this Amendment.

Claims 1-8 were rejected under 35 USC § 112, second paragraph. The claims have been amended to more particularly point out and distinctly claim the subject matter.

Claims 1-6 and 8 were rejected as being anticipated by U.S. Patent No. 5,876,367 to Kaganov et al. (Kaganov). Claim 7 was rejected as being unpatentable over Kaganov. These rejections are respectfully traversed.

Anticipation exists only if all of the elements of the claimed invention are present in a system or method disclosed, expressly or inherently, in a single prior art reference. Therefore, if it can be shown that there is one difference between the claimed invention and what is disclosed in the single reference, there can be no anticipation.

The present invention, as claimed in amended Claim 1, is directed to a cardiopulmonary bypass filter system that comprises a filter membrane having openings. Attached to the circumference of these holes are fibers that facilitate embolic material capture. Essentially, within these openings are smaller fibers attached to the perimeter. Kaganov fails to disclose the fibers. Accordingly, reconsideration and withdrawal of the anticipation rejection is respectfully requested.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d,488,20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d1596 (Fed. Cir. 1988)."

Applicants respectfully reiterate that Kaganov fails to disclose or even remotely suggest the claimed invention of Claim 1. As Claim 7 depends from Claim 1, Claim 7 is also allowable for the reasons set forth herein. Accordingly, reconsideration and withdrawal of the obviousness rejection is respectfully requested.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

By: 
Carl J. Evens
Reg. No. 33,874
Attorney for Applicants

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2518
Dated: September 8, 2004